II. Remarks

Reconsideration and allowance of the subject application are respectfully requested.

Claims 1-12 and 27-35 are pending in the application. Claims 1, 34, and 35 are independent.

Claims 2-6 and 12 were withdrawn from consideration as directed to a non-elected invention. Claims 13-26 were previously cancelled. Claims 1, 7-11, and 27-35 are under active consideration. All claim amendments submitted herein are made for reasons of clarity with respect to the specification and drawings, and not for reasons related to the statutory requirements for patentability.

Claims 1, 7-11 and 27-35 were rejected as being unpatentable over Faint, Schlereth, and Osawa, for the reasons discussed on pages 2-5 of the Office Action. Applicants respectfully traverse all art rejections.

Independent Claim 1 recites a novel combination of structure and/or function whereby a molding system flexible shoe assembly comprises a body for supporting a load and a force redirector. The body has an upper ***wearing*** surface configured to slideably engage a linearly moving complimentary surface of a supported member. The body also has a ***lower mounting surface*** configured to engage a complementary surface within the molding system and providing positioning and adjustment of said shoe assembly during installation. The force redirector (which is different from

the lower mounting surface) is disposed in the body in a plane below the upper wearing surface. The force redirector is configured to redirect the force from a leading edge and a trailing edge of the upper wearing surface to a central area in the body. The force redirector is also disposed ***substantially perpendicular*** to the linear movement of said body.

In contrast, Faint is not even directed to the same problem as the present invention - that of preventing premature wear in the leading and trailing edges of a bearing block. Furthermore, Faint has no force redirector which directs the force from the leading edge and from the trailing edge of the upper wearing surface to a central area in the body. In fact, Faint does not have a force redirector which is different from the lower mounting surface. The Office Action states that the claimed body comprises the pad 52. If so, then the body 52 must have a lower mounting surface, which the Office Action does not identify. The Office Action states that the force redirector is the "cylindrical mounting surface" at the bottom of body 52. Presumably, the Office Action uses the same structure as the body lower surface and as the force redirector, which are differently claimed structure according to the present invention. Lastly, Faint does not disclose any force redirector which is disposed substantially perpendicular to the body's linear movement.

Accordingly, the features of Claim 1 are nowhere disclosed or suggested by Faint.

Schlereth fails to disclose any body having an upper wear surface, as the webbed structures are bolted to fixed elements. The Schlereth structure comprises bending webs, not a linear moving force redirector. Again, the problem addressed by the present invention is not even recognized much less solved by Schlereth. Therefore, Schlereth fails to disclose or suggest (i) an upper ***wearing*** surface configured to slideably engage a linearly moving complimentary surface of a supported member, and (ii) a force redirector configured to redirect the force from a leading edge and a trailing edge of the upper wearing surface to a central area in the body. The Office Action proposes to invert the structure of Schlereth and then substitute a wear surface of Osawa for the ball bearings of Schlereth "to reduce the number of components of the device thereby reducing the cost and assembly time of the device." Respectfully, this is extremely weak motivation-to-combine; such motivation would enable any reference to be combined with any other reference at any time to produce any claimed combination. The law on hindsight reconstruction is clear.

To prevent hindsight reconstruction, the law is clear that a *prima facie* case of obviousness can be established **only** by showing some **objective** teaching in the cited art which would lead an individual of ordinary skill in

this art to combine the relevant references. *See Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Patent Office Board of Appeals 1993). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined **only** if there is some suggestion or incentive to do so. The mere fact that the prior art may be modified does not make the modification obvious unless the prior art suggested the desirability of the modification. *See ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1578, 221 USPQ 929, 933 (Fed. Cir. 1984). It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *See In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

It is well established that, in order to sustain a rejection under 35 U.S.C. §103, it is the burden of the USPTO to establish a *prima facie* case of obviousness, *In re Reuter*, 651 F.2d 751, 210 USPQ 249 (CCPA 1981). In asserting such a case of obviousness, the Examiner must propose some modification of a particular reference or a combination thereof with another reference in order to arrive at the claimed invention. In this regard, the teachings of a single prior art reference or a primary prior art reference (which is combined

with one or more secondary prior art references) must be sufficient to justify a conclusion that any proposed modification or combination of references is what one of ordinary skill in the art would have found obvious to do at the time the invention was made, *In re Linter*, 458 F.2d 1013, 173 U.S.P.Q. 560, 562 (CCPA 1972). Moreover, the Courts have held that there must be some logical reason apparent from the evidence of record that would justify a modification or combination of prior art references, *In re Regel*, 188 USPQ 132 (CPPA 1975). If there is no such reason, the *prima facie* case of obviousness has not been made out, Oscar Mayer Foods Corp. v. Sara Lee Corp., 15 USPQ (2d) 1204, (D.C. Wis., 1990).

Hindsight combination of references is not a valid basis for rejection under 35 U.S.C. §103, *In re Adams*, 148 U.S.P.Q. 742 (CPPA 1966) and *In re Skoll*, 187 U.S.P.Q. 481, 484 (CCPA 1975). Further, in *Twin Disc Inc. v. United States*, 10 Cl. Ct. 713; 231 USPQ 417, 425 (Cl. Ct. 1986), the Court stated:

> ... it is now clear beyond cavil that it is not permissible to ascertain factually what the inventors did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct the claimed invention.

Citing *Orthopedic Equipment Co., Inc. v. United States*, 702 F.2d 1005, 1012; 217 USPQ 193, 199 (Fed. Cir. 1983), the Court in *Twin Disc* further stated that it is incorrect to use the

patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.

More egregiously, the Office Action fails to point to any motivation or suggestion which would lead the person of ordinary skill in the art at the time the invention was made to combine Schlereth and Osawa in the manner ***claimed***. The law is clear that the Examiner must make "findings as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of [the] invention to make the combination in the manner claimed." *In re Kotzab*, 217 F. 3d 1365, 1371 (Fed. Cir. 2000). Since the stated motivation-to-combine ("to reduce parts and cost") is woefully inadequate to support a *prima facie case* of obviousness, the claim is fully patentable over the proposed combination.

Independent Claim 34 recites a novel combination of structure and/or function whereby a molding system flexible shoe assembly comprises a body for supporting a load and a force redirector. The body has an upper ***wearing*** surface configured to slideably engage a complimentary surface of a supported member moving in a linear relationship with the body. The force redirector comprises a pair of slots in the body forming a web ***having an integral bearing surface thereon***. The force redirector is disposed in the body in a plane below said upper surface and is configured to

redirect the linearly moving force from a leading edge and a trailing edge of the upper surface to a central area in the linearly moving body.

Neither Schlereth nor Osawa (nor any combination thereof) discloses or suggests a force director having a pair of slots in the body forming a web ***having an integral bearing surface thereon,*** where the force redirector is configured to redirect the linearly moving force from a leading edge and a trailing edge of the upper surface to a central area in the linearly moving body. Moreover, no legally sufficient motivation has been set forth in the record to support the combination of Schlereth and Osawa in the manner claimed (for the reasons noted above). Accordingly, the claimed invention is fully patentable over the cited art.

Independent Claim 35 recites a novel combination of structure and/or function whereby a molding system flexible shoe assembly comprises a body for supporting a load and a force redirector. The body has an upper ***wearing*** surface configured to slideably engage a linearly moving complimentary surface of a supported member. The force redirector is disposed in the body in a plane below the upper surface and ***substantially perpendicular*** to the linear movement of the body. The force redirector is configured to redirect the linearly moving force from a leading edge and a trailing edge of the upper wearing surface to a central area

in the body. The body includes at least ***one fixation bore extending lengthwise through a lower support of said body.***

In contrast, none of Faint, Schlereth and Osawa (nor any combination thereof) discloses or suggests the force redirector being disposed in a plane below the upper surface and ***substantially perpendicular*** to the linear movement of the body or at least ***one fixation bore extending lengthwise through a lower support of said body.*** Furthermore, no legally sufficient motivation has been set forth in the record to support the combination of Schlereth and Osawa in the manner claimed (for the reasons noted above). Accordingly, the claimed invention is fully patentable over the cited art.

In view of the above, Applicants submit that the present application is in condition for allowance. Prompt issuance of a notice thereof is respectfully requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 625-3507.

All correspondence should continue to be directed to our address given below.

Respectfully submitted,

Attorney for Applicant
Richard P. Bauer
Registration No. 31,588

PATENT ADMINISTRATOR
KATTEN MUCHIN ROSENMAN LLP
525 West Monroe Street
Chicago, Illinois 60661-3693
Facsimile: (312) 902-1061

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